



26 SEP 2006

Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin NJ 08830

In re Application of: BRAUN, Michael, et al. :

U.S. Application No.: 10/500,414 :

PCT No.: PCT/ EP02/14166 :

DECISION

International Filing Date: 12 December 2002 :

Priority Date: 27 December 2001 :

Attorney's Docket No.: 2000P16272WOUS :

For: AUTOMATED METHOD FOR GENERATING :  
PROGRAM MODULES USED FOR :  
CONTROLLING FIELD DEVICES BY MEANS :  
OF A MACHINE-READABLE PARAMETERED :  
DESCRIPTION OF THE FIELD DEVICES :

This decision is issued in response to the "Request To Withdraw The Holding Of Abandonment" filed 13 July 2006, considered herein under 37 CFR 1.8(b). No petition fee is required.

### **BACKGROUND**

On 12 December 2002, applicants filed international application PCT/EP02/14166. The application claimed a priority date of 27 December 2001, and it designated the United States. On 10 July 2003, the International Bureau (IB) communicated a copy of the international application to the United States Patent And Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months after the priority date, i.e., 27 June 2004.

On 24 June 2004, applicants filed a transmittal letter for entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 10 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 16 June 2006, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a timely response to the Notification Of Missing Requirements.

On 13 July 2006, applicants filed the petition considered herein. The petition requests withdrawal of the holding of abandonment, stating that a response to the Notification Of Missing Requirements was timely filed via facsimile on 10 August 2005.

### DISCUSSION

The present petition is accompanied by a document entitled "Response To Notification Of Missing Requirements Under 35 U.S.C. 371" that references an attached declaration, contains the authorization to charge Deposit Account No. 19-2179 the required surcharge, and bears a "Certificate Of Mailing" dated 10 August 2005. The Certificate Of Mailing, executed by Ann Hickey, states that the accompanying materials were transmitted to the USPTO by facsimile. The petition also includes a copy of an executed declaration, and the confirmation report from applicants' facsimile machine.

The application file does not contain the materials purportedly filed by facsimile on 10 August 2005. In order to confirm the 10 August 2005 filing of the materials accompanying the present petition, applicants must satisfy the requirements set forth in 37 CFR 1.8(b), which states the following:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Referring to the statement required by 37 CFR 1.8(b)(3), MPEP § 512 states the following: "If the person signing the statement did not sign the certificate of mailing, then the

person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission.”

The present petition, which is signed by John P. Musone, states that the attached materials were submitted by facsimile on 10 August 2005. However, Mr. Musone is not the person who executed the Certificate Of Mailing, and he does not state “how he has firsthand knowledge of the previous mailing or transmission” as required by MPEP § 512; the petition does not include a confirming statement from Ann Hickey (the person who executed the Certificate Of Mailing on the response materials). Based on the above, the present petition does not satisfy the requirement of 37 CFR 1.8(b)(3).

### CONCLUSION

Applicants’ petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** of the mail date of the present decision and must include the materials required to satisfy 37 CFR 1.8(b)(3), as discussed above.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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